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In the Supreme Court of the United States

No. 1079.
OCTOBER TERM, 1967.

THE F. E. MYERS & BRO. CO.,
Petitioner,
vs.
FMC CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Sixth Circuit.

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There are no special or important reasons for granting the writ prayed for in this case. There is no conflict among the decisions of courts of appeals on any question of law or fact that has been decided in this case. There is no important question of federal law in this case which has not been, but should be, settled by this Court nor does the decision of the Court of Appeals in this case conflict with any applicable decisions of this Court.

QUESTIONS PRESENTED.

The two questions presented in the Petition are based upon inaccurate argumentative and inaccurate factual assertions not supported by the record.

Both questions assume an admission of prior "use" by the inventor when, in fact, no such use was admitted or proved. That the inventor, after beginning experimental work in 1942 and 1943, operated the first experimental

unit of the patented machine to his own satisfaction in 1944 [PA144b, 146b] [1] is the only testimony on the subject.

In terms of the record in the case, the first question is: Does the inventor's bare statement at trial that one or two years after starting experimental work he first operated his first experimental unit to his satisfaction necessarily and as a matter of law, constitute such proof of a "use" as to shift onto the patentee the burden of coming forward with still additional evidence that that same first operation was experimental or alternatively, was not a public use?

In addition to the inaccurate assumption mentioned above, the second question presented in the Petition further assumes that earlier patents of the inventor were for substantially the same subject matter as the patent in suit. Actually, although the inventor's earlier patents and the patent in suit all related broadly to orchard sprayers, none of the earlier patents, either alone or combined, taught the combination claimed in the patent in suit [F24, 32—DA299a, 300a]. Moreover, important elements recited in each of the infringed claims are not found in any of the earlier patents [F25-29—DA299a, 300a].

The second question presented on the record is: Does a time lapse between the first satisfactory experimental operation in 1944 and the filing of a patent application on January 9, 1946 constitute such an unreasonable delay as to be abandonment of the invention or an election to forego patent protection in favor of keeping the invention a trade secret merely because the inventor had earlier contributions and obtained patents in the same general field?

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[1] References herein to Plaintiff-Appellee's Appendix in the Court of Appeals are indicated by "PA" and to Defendant-Appellant's Appendix by "DA." Findings of the District Court are indicated by "F." The Findings are printed at DA295a-301a.

STATEMENT OF THE CASE.

The Daugherty patent here involved relates to spraying machines for use in orchards [PA70b, F5—DA295a]. Such machines generate a blast of air which is used to carry insecticide to the trees [F5—DA295a]. Two distinct features of the patented machine are: 1.) a combination of particularly formed fan and deflector elements so as to provide an extremely efficient air flow without turbulence [DA62a, 63a; F6—DA295a] and 2.) an arrangement of these elements with others in a way to prevent recirculation of corrosive insecticide laden air through the machine itself [DA61a, 62a; F6—DA295a].

The testimony relied upon by Petitioner (herein referred to as Myers) merely shows that the inventor, George Daugherty, began experimental work on his machine "in late '42 and early '43" and made his first satisfactory operation in "'44" [Petition 3, 4]. On January 9, 1946 he filed his patent application on the machine as operated in 1944 but with certain improved parts [DA109a, 110a].

There is no evidence at all in this case that there was any *use* of the machine in 1944. There has been no hint that the operation in 1944 was for any commercial purpose. There is no evidence of any demonstration or attempted sale. There is no evidence of using the 1944 machine for its intended purpose to spray insects. There is not even any evidence that the 1944 experimental operation was with an insecticide.

Contrary to the statement of Myers at page 8 of the Petition, the patentee never stated that his operation of the machine "was not experimental." Myers directs this Court's attention to no portion of the record to support this statement. We think there is none.

Even from the testimony relied upon in the Petition it is clear that the 1944 operation was but a further step in the experimentation begun in 1942 and 1943. But the 1944 machine was even further characterized by the inventor as his "first experimental unit" in the following testimony:

> "Q. Mr. Daugherty, you remember you talked to Mr. Cook about a 1945 machine and a 1944 machine. You are talking about two different machines, is that correct?
>
> "A. The first one was the fan that we took out of a—more or less the bone pile of Hartzell and built the first experimental unit. And we did a lot of work on that ourselves and got it to where it was doing a very, very good spray job.
>
> "Q. Is that the one you are talking about from 1944?
>
> "A. That is right. And we had trouble with bearing trouble, and we had to beef up the bearings; and we were having some vane trouble, and we went further in design of that; and the head that was shipped to us, I believe it was in '45, I think '45, from Hartzell, containing these improved parts, these improved features." [DA146b]

The District Court made no finding of any prior use and the reason for no such finding is abundantly clear. Myers had not even attempted to prove such a use. In the words of the Court of Appeals:

> "The District Court made no findings of fact on this critical issue of prior public use, as required by Rule 52(a), Federal Rules of Civil Procedure. While this Court generally requires strict observance of this Rule relating to sufficiency of the findings of fact (*Deal v. Cincinnati, Board of Education*, 369 F. 2d 54 (6th Cir. 1966); *Tappan Co. v. General Motors Corp.*, ____ F. 2d ____ (6th Cir., July 17, 1967) [380 F. 2d 888]), the record itself is unsatisfactory on this point

and affords scant basis for a determination." [Appendix to Petition 19]

Despite Myers' general assertion in its Answer of "public use" prior to Daugherty's invention [DA8a] Myers never asserted a prior use by the inventor himself in any pleading or at any time until after trial. Myers made no effort at trial to prove such a use. Actually, the only testimony on the point of the inventor's 1944 operation of his first experimental unit, including that portion of the testimony now relied upon in the Petition, was part of Respondent's (herein referred to as FMC) rebuttal. Although Myers called the inventor, Daugherty, as a witness in its defense, the question of prior use was not even raised.

No use of any kind has been shown to have occurred in 1944. Much less is there any showing of a public use.

REASONS FOR DENYING THE WRIT.

The Petition should be denied because the only questions raised are the conventional questions of prior public use which have long since been decided by this Court and by the courts of the various circuits. These same questions were considered by the Court of Appeals here. Relying upon the earlier decisions of this Court and recognizing the unity of holdings in the other circuits, the Court of Appeals first discussed the law as to prior public use [Appendix to Petition 17, 18] and then outlined what burden of proof was to be carried by each party [Appendix to Petition 18, 19]. The Court then held simply:

> "Appellant has not carried its burden of going forward with the evidence on this point by assuming that the use must have occurred in an orchard, arguing, 'how else could one know that the sprayer operated satisfactorily except in a grove where anyone could see * * *.'" [Appendix to Petition 19]

The alleged conflict among the courts of appeals is non-existent. Myers now contends that a conflict of thirty-five years ago between the Second and Sixth Circuits referred to in Judge Learned Hand's decision in *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F. 2d 860 (2d Cir. 1933) still exists. But Myers itself, at page 6 of its Petition for Rehearing before the Court of Appeals stated:

> "* * * the difference, if any, between the logic of Judge Hand in *Aerovox*, and the earlier decision of this Circuit in *Austin Machinery Co. v. Buckeye Ditcher Traction Co.*, 13 F. 2d 697, 700 (6th Cir. 1926) no longer exists in view of this Court's adoption of the First Circuit rule from *Atlas v. Eastern Air Lines, Inc.*, 311 F. 2d 156 (pages 7 and 8 of the Decision)."

ARGUMENT.

Using the same tests relied upon by the various circuits, the Court of Appeals properly held that Myers had not met its burden of proving a prior use.

The Court of Appeals decision is based upon well settled law. It relied upon *Atlas v. Eastern Air Lines, Inc.*, 311 F. 2d 156 (1st Cir. 1962) *cert. denied*, 373 U. S. 904 (1963) and *Koehring Co. v. National Automatic Tool Co.*, 362 F. 2d 100 (7th Cir. 1966) in support of the proposition that once a prior public use is shown, the burden is then on the patentee to prove such use to be experimental [Appendix to Petition 18, 19]. The Court of Appeals here then is well aligned with the other circuits on this universally held doctrine. Still other circuits have shown a similar accord, *A. Schrader's Sons, Inc. v. Wein Sales Corp.*, 9 F. 2d 306 (2d Cir. 1925); *Aerovox Corp. v. Polymet Mfg. Corp.*, 67 F. 2d 860 (2d Cir. 1933); *Wendell v. American Laundry Machinery Co.*, 248 Fed. 698 (3d Cir. 1918); *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F. 2d 381 (10th Cir. 1965) *cert. denied* 383 U. S. 933 (1966).

But the Court of Appeals here and the other circuits are equally united in demanding that the burden of proving the prior use itself be upon the party alleging that use.[2] The Court of Appeals relied upon *Atlas v. Eastern Air Lines, Inc., supra,* 311 F. 2d at 160, *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F. 2d 381 (10th Cir. 1965), *cert. denied* 383 U. S. 933 (1966) and *Julian v. Drying Systems Co.,* 346 F. 2d 336, 338 (7th Cir. 1965) in support of this latter proposition [Appendix to Petition 18] and held that Myers did not carry its burden of showing a prior use [Appendix to Petition 19].

Myers' failure in this respect is obvious when it is understood that an "operation"—particularly a first operation of a first experimental unit—is not a use. Such an operation is all that Myers even contends to have proved. While a machine must be operated to be used, the converse is not true. Use of machines such as orchard sprayers necessarily connotes spraying trees in an orchard for some practical purpose—not mere testing.

Daugherty testified that he operated his machine in 1944 but there was no showing at all that he used the machine. The question of use was never presented to Daugherty although at the trial he testified as a witness for both Myers and FMC.

But even if the first operation of the inventor's "first

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[2] *Atlas v. Eastern Air Lines, Inc.,* 311 F. 2d 145 (1st Cir. 1962) *cert. denied* 373 U. S. 904 (1968); *A. Schrader's Sons, Inc. v. Wein Sales Corp.,* 9 F. 2d 306 (2d Cir. 1925); *Wendell v. American Laundry Machinery Co.,* 248 Fed. 698 (3d Cir. 1918); *Jordan v. Hemphill Co.,* 180 F. 2d 457 (4th Cir. 1950); *Zachos v. Sherwin-Williams Co.,* 177 F. 2d 762 (5th Cir. 1949); *United Parts Mfg. Co. v. Lee Motor Products, Inc.,* 266 F. 2d 20 (6th Cir. 1959); *Julian v. Drying Systems Co.,* 346 F. 2d 336 (7th Cir. 1965); *Twyman v. Radiant Glass Co.,* 56 F. 2d 119 (8th Cir. 1932); *Paraffine Companies, Inc. v. McEverlast, Inc.,* 84 F. 2d 335 (9th Cir. 1936); *McCullough Tool Co. v. Well Surveys, Inc.,* 343 F. 2d 381 (10th Cir. 1965).

experimental unit" were to be considered such a use, evidence of the same character and from the same witness showed that same operation to be experimental [PA144b 146b].

There is no showing of any purposeful delay such as to be an overextension of monopoly.

In arguing that Daugherty had overextended his monopoly, Myers questions the Court of Appeals' lack of comment upon this Court's decision of *Woodbridge v. United States,* 263 U. S. 50 (1923). Upon a review of *Woodbridge* it is all too clear why no comment was deemed necessary by the Court of Appeals. In *Woodbridge,* after seasonably filing a patent application, the inventor purposely delayed its issuance as a patent for nine and one-half years. The reason for this delay, admitted in writing, was that it was "only lately that any immediate opportunity of rendering it pecuniarily available has occurred." 263 U. S. at 53.

This nine and one-half years delay, with proven intent, in *Woodbridge* bears no relation to the facts of the instant case. There is not even a hint of purposeful delay in the present case.

Also appropriate here is this Court's comparison of *Woodbridge* with its earlier opinion in *U. S. v. American Bell Telephone Co.,* 167 U. S. 224 (1897) known as the *Berliner* case. Referring to the *Berliner* case the Court stated in *Woodbridge*:

> "A reading of Mr. Justice Brewer's opinion in that case shows that the attention of the court was chiefly directed to the issue whether as a fact the delay was due to the design of the owner of the invention or to circumstances over which it had no control, including the rules of the Patent Office, the delays of the ex-

aminers, and the peculiar situation as to applications for patents in that active field of invention. The court found this issue against the government and in favor of the patentee, whose patent the government was attempting to cancel for this fraud, and could only cancel by clear and convincing proof. In the case at bar the design of the inventor is disclosed by his own avowal and his plan of nonaction was not in accord with the rules of procedure in the Patent Office, but was in plain violation of the statutory law." 263 U. S. 25, 62, 63.

The clear and convincing proof of the fraudulent delay demanded in *Woodbridge* and in the *Berliner* case is not only absent in the instant case, but has not even been attempted.

CONCLUSION.

The petition for certiorari should be denied.

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